



Application No: GB0422298.0

Examiner: Kalim Yasseen

Claims searched: All

Date of search: 9 December 2004

## Patents Act 1977: Search Report under Section 17

### Documents considered to be relevant:

Category	Relevant to claims	Identity of document and passage or figure of particular relevance
X, Y	X: 1, 8, 9; Y: 1-15	XP004304805 Millau: an encoding format for efficient representation and exchange of XML over the Web, COMPUTER NETWORKS, ELSEVIER SCIENCE PUBLISHERS B.V., AMSTERDAM, NL, June 2000
Y	1-15	WO2003/014971 A2 (CELECTIVITY) see whole document especially page 4 lines 6-11, claim 7

### Categories:

X	Document indicating lack of novelty or inventive step	A	Document indicating technological background and/or state of the art.
Y	Document indicating lack of inventive step if combined with one or more other documents of same category.	P	Document published on or after the declared priority date but before the filing date of this invention.
&	Member of the same patent family	E	Patent document published on or after, but with priority date earlier than, the filing date of this application.

### Field of Search:

Search of GB, EP, WO & US patent documents classified in the following areas of the UKC<sup>W</sup> :

G4A

Worldwide search of patent documents classified in the following areas of the IPC<sup>07</sup>

G06F

The following online and other databases have been used in the preparation of this search report

Online: EPODOC, FULLTEXT, INSPEC, INTERNET, JAPIO, NPL, WPI, XPESP



Your ref : Bin+Text Parser (UK)

Application No: GB0422298.0

Applicant : Symbian Software Ltd

Latest date for reply: 7 October 2005

Examiner : Kalim Yasseen

Tel : 01633 813623

Date of report : 10 December 2004

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## Patents Act 1977

### Combined Search and Examination Report under Sections 17 & 18(3)

#### Patentability

1. I consider your invention to be excluded from patentability under section 1(2)(c) of the Act, as relating to a program for a computer.
2. The invention concerns a computing device programmed with a client that can operate with a parser or generator for both text and binary mark up languages. The client uses a unique integer value that can be interpreted in an index of elements, attributes and attribute values needed to describe a particular type of mark-up document. The index maps the unique integer value to (i) a token associated with predefined element, attribute or attribute value to enable a token based mark up language to be handled and also to (ii) a string associated with a predefined element, attribute or attribute value to enable a string based mark-up language to be handled. It is unclear why the particular methodology adapted by the invention gives rise to a technical contribution. It would appear that methodology employed (involving mapping) appears in substance to be a program for a computer as such. The hardware used in the implementation of the invention appears to be of a conventional nature and does not give rise to a technical contribution
3. In order to make an excluded thing patentable it is necessary for an invention to make a technical contribution so in another relevant case law, *Fujitsu's Application* [1997] RPC 608, Judge Aldous LJ said:

"...it is and always has been a principle of patent law that mere discoveries or ideas are not patentable, but those discoveries and ideas which have a technical aspect or make a technical contribution are. Thus the concept that what is needed to make an excluded thing patentable is a technical contribution is not surprising. That was the basis for the decision of the Board in *Vicom*. It has been accepted by this Court and the EPO and has been applied since 1987. It is a concept at the heart of patent law."

#### Interpretation of the law

4. According to both s.1(2) of the Patents Act and Art. 52(3) of the EPC, an invention is only excluded to an extent that a patent or application for a patent relates to that thing *as such*.



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5. The Patent Office Practice Notice issued on 24 April 2002 entitled "Patents Act 1977: interpreting section 1(2)" provides a convenient summary of the approach to be adopted in determining whether an invention constitutes an excluded item *as such*. The practice notice can be summarised as saying that even if an invention relates to an excluded field, it will not be refused as being unpatentable if it provides a technical contribution. In other words, if it makes a technical contribution it does not relate to the excluded item "*as such*".
6. It is an underlying tenet of UK law, as established in *Merrill Lynch's Application* [1989] RPC 561 on page 569, that it is the **substance** of an invention that is important, not the **form** of claim adopted. Accordingly it is not possible to render patentable an inherently unpatentable method merely through the specification of technical means.
7. This approach is somewhat inconsistent with that adopted by the EPO Board of Appeal in *Pension Benefit Systems Partnership* (T 931/95) which decided that apparatus claims were fundamentally technical and therefore not caught by the exclusion whilst corresponding method claims were refused as being excluded. The Board went on to refuse the apparatus claims having decided that only technical features could contribute to the required inventive step. 10.
8. This inconsistency between the UK and EPO approach has been expressly considered by the Comptroller's hearing officers on a number of occasions, notably *Hutchin's Application* (BL O/209/01) and *Pintos Global Services's Ltd.'s Application* (BL O/171/01). On both these occasions the hearing officer recognised the desirability of consistency between the UKPO and the EPO in this area but concluded that where there was a divergence, the UK Office was bound to follow the approach taken by the UK courts. Thus in UK law substance prevails over form.
9. However, a recent decision by the EPO Board of Appeal in *Hitachi* (T 0258/03) appears to revise the thinking adopted in *Pension Benefits* such that corresponding method and apparatus claims are treated in the same way. Consequently methods which involve the use of technical means are considered by the EPO to be inventions within the meaning of Article 52(1) of the EPC.
10. A number of hearing officers have found it convenient to address the following two questions in assessing whether an invention is excluded from being patentable:

Does the invention fall within the area of excluded subject matter mentioned in s.1(2) of the Act? If the answer is "yes",

Does the invention make a technical contribution such that it cannot be said to amount to excluded matter as such?



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11. Only if the answer to the second question is “no” is the invention not patentable under s.1(2).

#### **Inventive step**

12. The invention as defined in claims 1-15 is obvious in view of what has already been disclosed in the following documents:

XP004304805; Millau: an encoding format for efficient representation and exchange of XML over the Web, Computer Networks, Elsevier Science Publishers B.V., Amsterdam, NL, June 2000, see whole document

WO 2003/014971 A2 (CELECTIVITY)      see whole document especially page 4  
lines 6-11, claim 7

13. XP004304805 discloses an encoding format ( Millau) for efficient representation and exchange of XML over the Web. The document discloses compressing XML based documents i.e. binary and string based mark-up languages. The document appears to indicate that when handling XML based languages the mapping of tags to tokens is utilised. This mapping is not described in the manner required by the independent claims but appears to render obvious the concept of using mapping techniques in handling text & binary based mark-up languages mentioned in these claims. The Millau code appears to be in the form of APIs. It would appear that the Millau APIs could be used in the extensible framework disclosed in the CELECTIVITY document thus rendering claims 1-15 obvious.

#### **Clarity**

14. In claim 1 the words ‘to enable’ appear to have been used twice (see lines 7-8). The clarity of claim 8 (lines 6-7) & claim 9 (lines 6-7) is similarly impaired.
15. When amending the claims care should be taken to avoid conflict with related application GB0422300.4

#### **Other matters**

16. The description should reflect any changes that are made to the claims.